



15 FEB 2008

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In re Application of TRIBELSKY et al. :
Application No.: 10/566,983 : DECISION ON PETITION
PCT No.: PCT/IL04/00718 :
Int. Filing: 04 August 2004 : UNDER 37 CFR 1.47(a)
Priority Date: 04 August 2003 :
Attorney Docket No.: P-7784-US :
For: METHOD FOR ENERGY COUPLING :
ESPECIALLY USEFUL FOR DISINFECTING :
AND VARIOUS SYSTEMS USING IT :

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 19 November 2007, to accept the application without the signatures of joint inventor ZAMIR TRIBELSKY.

BACKGROUND

On 02 February 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 19 July 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 19 November 2007, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor ZAMIR TRIBELSKY, alleging that Mr TRIBELSKY refused to sign the application and is now unavailable.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor was provided.

With regard to item (4), the declarations executed by the available joint inventors on their behalf and on behalf of the non-signing inventor were submitted. Item (4) is satisfied.

Inventor's Refusal to Sign

With respect to Item (2) above, the declaration by Amir Cohen, Chief Financial Officer of Atlantium Technologies, Ltd. was attached to the petition, detailing the efforts made to obtain the nonsigning inventor's signature. Mr. Cohen detailed several attempts to contact the nonsigning inventor via his attorney. According to the declaration, the attorney for the nonsigning inventor indicated that Mr. Tribelsky "might consider signing the documents if he were to receive payment." On 10 December 2006, a further communication to the nonsigning inventor's attorney was sent along with documentation relating to the employer/employee agreements.

Thereafter, on 2 September 2007, Mr. Cohen "sent via registered mail a package containing a copy of the above-identified application, including preliminary amendment and a declaration and power of attorney to ZAMIR TRIBELSKY's last known address...". The package was returned as unclaimed. On 14 October 2007, Mr. Cohen made an attempt to deliver the documents to the nonsigning inventor's last known address via a postal messenger without success, indicating that Mr. Tribelsky no longer resided at the address. Thereafter, Petitioner did not show how he attempted to locate the nonsigning inventor.

The fact that the papers were returned as "undeliverable" cannot be construed as a refusal to sign. It may be that the nonsigning inventor was at work, out of town or in the hospital when the attempt to deliver the papers was made or that he has since moved from the last known address. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.¹

Unavailability of Inventor

With respect to counsel's inability to find or reach Mr. Tribelsky, Petitioner does not demonstrate what "diligent efforts" were undertaken by Petitioner to locate Mr. Tribelsky and obtain his signature on the declaration, stating that the application papers were sent to Mr. Tribelsky and were returned by the postal service/messenger as undeliverable.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a

¹ A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition. (Emphasis added.)

nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate Mr. Tribelsky were not pursued and documented, such as Internet searches, contact with the joint inventors to obtain Mr. Tribelsky's current address, a forwarding address or current email address and/or current employer. No attempt to reach Mr. Tribelsky's by telephone or further contact with his attorney was made. No request from the Postal Service for his forwarding address was made. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for Mr. Tribelsky's new address was made. Since no attempts to locate inventor Tribelsky were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Mr. Tribelsky is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4).

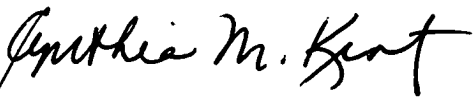
Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/566,983 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Tribelsky's refusal to sign, either in writing or by telephone, these documents or (2) a first hand statement of the "diligent efforts" made to contact the nonsigning inventor Tribelsky. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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